

### **REMARKS**

Claims 1-16 are pending in this application after this amendment. Claims 1, 3, and 14 are independent. In light of the remarks included herein, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections.

In the outstanding Official Action, the Examiner rejected claim 14 under 35 U.S.C. §102(b) as being anticipated by Trotta, Jr. (USP 5,595,264) (hereinafter “Trotta”); rejected claims 1-13 under 35 U.S.C. §103(a) as being unpatentable over Trotta in view of Garver (USP 7,114,656); and rejected claims 15-16 under 35 U.S.C. §103(a) as being unpatentable over Trotta in view of Garver and further in view of Murrah (USP 5,804,807).

#### **Claim Rejection - 35 U.S.C. §102**

The Examiner rejected claim 14 asserting Trotta discloses all of the claims elements.

In their previous reply, Applicants argued that Trotta fails to anticipate claim 14 as Trotta fails to teach or suggest customer identifying information written onto another wireless tag. In response to this argument, the Examiner asserts that he is not affording patentable weight to the type of information stored on the wireless tag. He asserts that this claim element is a recitation of intended use and that the structure of the claim is the same as the structure recited in Trotta. The Examiner concludes that since the structure is Trotta is capable of performing the intended use, then the teachings are sufficient to teach the claim element. Applicants respectfully disagree with the Examiner’s interpretation of “intended use.”

The Examiner’s form paragraph used in response to Applicants’ arguments is found under the heading “Answering Asserted Advantages” in the MPEP. In contrast, the arguments presented in our previous reply recite elements that are directly recited in the claims and are not asserted advantages as a result of the claimed invention. As such, the Examiner is clearly misinterpreting the rules for claim interpretation.

It is well established that the Examiner must afford patentable weight to all of the elements recited in claim. Applicants submit that the Examiner's failure to afford proper patentable weight to the functionality of the tag reader, as clearly recited in the body of the claim is wholly improper.

The Examiner further asserts that customer identifying information amounts to non-functional descriptive material. However, the claims, when read in light of the specification, provide for customer identifying information read from a wireless tag. The information that is read from the tag is then transmitted together with the commodity information to an information-processing apparatus. Applicants submit that the customer identifying information is not merely non-functional descriptive material.

For the reasons set forth in their previous reply, Applicants maintain that Trotta fails to teach or suggest the tag reader for reading customer identifying information written onto another wireless tag. Thus, claim 14 is not anticipated by Trotta.

### **Claim Rejections - 35 U.S.C. §103**

Claims 1-13 stand rejected under 35 U.S.C. § 103 as being unpatentable over Trotta in view of Garver.

In their previous reply, Applicants argued that the cited references fail to teach or suggest "comparing at the information-processing apparatus the commodity information which has already been relayed to the information-processing apparatus, with commodity information **which is sent from the portable terminal to a POS apparatus at a sales counter** and is then entered into the information-processing apparatus."

In response to this argument, the Examiner asserts in the final Official Action on page 11-12 as follows:

.. a comparison must be made since the file that is stored at the in-store computer must contain some type of identifier, which would identify the scanner with the customer, and when the scanner is placed back at the scanner terminal, another type of identifier must be transmitted from the scanner terminal to the in-store computer in order to compare that the two identifiers are the same in order to release the customer's payment card and the printing of the receipt of the total purchases.”

However, the court in *In re Robertson* held “to establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’” 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

The Examiner is asserting that it is inherent that the system compares at the information-processing apparatus the commodity information which has already been relayed to the information-processing apparatus, with commodity information which is sent from the portable terminal to a POS apparatus at a sales counter and is then entered into the information-processing apparatus. This assertion is supported by his statement that the system must compare **identifier information** in order to confirm the transaction. However, it appears that the Examiner is misinterpreting the claim language.

Claim 1 clearly requires that the system compares at the information-processing apparatus **the commodity information** which has already been relayed to the information-processing apparatus, **with commodity information** which is sent from the portable terminal to a POS apparatus at a sales counter and is then entered into the information-processing apparatus.

By the Examiner's own statement, in considering the cited art, it is possible to perform the transaction in a different manner, namely by comparing **identifier information** that identifies the scanner used by the customer, and not commodity information as required by the

claim. Thus, since it does not necessarily flow that the system compares at the information-processing apparatus the commodity information which has already been relayed to the information-processing apparatus, with commodity information which is sent from the portable terminal to a POS apparatus at a sales counter and this then entered into the information-processing apparatus, Applicants maintain that it is not inherent that the system must compare the commodity information as required by the claim.

For at least the reasons noted above, Applicants maintain that the combination of the teachings of the cited references fail to teach or suggest all of the claim elements and, thus, fails to render pending claim 1 obvious.

It is respectfully submitted that claims 2 and 15 are allowable for the reasons set forth above with regard to claim 1 at least based on their dependency on claim 1.

Regarding claim 3, as noted above, Trotta fails to teach or suggest the POS apparatus communicating with the information processing apparatus in the manner claimed. Further, Garver fails to cure the deficiencies of the teachings of Trotta. Thus, for the reasons set forth above, Applicants respectfully submit that claim 3 is patentable over the references as cited. It is respectfully requested that the outstanding rejection be withdrawn.

It is respectfully submitted that claims 4-13 and 16 are allowable for the reasons set forth above with regard to claim 3 at least based upon their dependency on claim 3.

### **Conclusion**

In view of the above remarks, Applicants believe the pending application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Catherine M. Voisin Reg. No.

Application No. 09/995,652  
Amendment dated September 10, 2008  
After Final Office Action of June 10, 2008

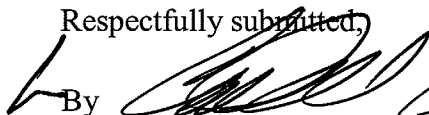
Docket No.: 1247-0464P

52,327 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.147; particularly, extension of time fees.

Dated: September 10, 2008

Respectfully submitted,

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